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APR 22 2005

OFFICE OF PETITIONS

In re Application of :
Howard Kapple :
Application No. 10/046,045 : ON PETITION
Filed: 16 January, 2002 :
For: Precision aid :
:

This is a decision on the petition filed on 20 November, 2004, to withdraw the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a) or (b)." This is not a final agency action.

The application became abandoned on 26 December, 2003, for failure to submit a timely response to the non-final Office action mailed on 25 September, 2003, which set a three (3)-month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 20 September, 2004.

Petitioner asserts that a timely reply was filed on 12 November, 2003, but that as petitioner, *pro se*, did not properly identify the papers as a reply to the Office action in the above-

identified case, the papers were treated as a new application by the Office, and were assigned Application No. 10/705,678. A Notice to File Missing Parts was mailed in Application No. 10/705,678 on 26 May, 2004. Petitioner submitted an additional response on 4 March, 2004, which was treated as a new application and accorded Application No. 10/792,671.

37 CFR 1.5(a) states:

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07 /123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patent should also state the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or

other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

(emphasis added)

37 CFR 1.53(a) states:

Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

A review of the official file for the above-identified applications reveals that the papers filed on 12 November, 2003, and 4 March, 2004, did not include the application number, group art unit, application filing date, or any indication that the papers were in response an application for patent. It is further noted that the examiner's name, Linh Truong, appears only on the paper filed 4 March, 2004, and on that paper Mr. Truong is not clearly identified as the relevant patent examiner. As such, the papers do not comply with 37 CFR 1.5. Without the required information, it is not possible for the Office to match the papers with the proper file.

As petitioner did not provide the required identifying application on the papers filed on 12 November, 2003, and 4 March, 2004, the Office did not err in treating them as new applications. Moreover, while it is unfortunate that applicant was unfamiliar with the rules of patent practice, such lack of knowledge does not relieve applicant of the responsibility of complying with Office regulations and procedures. As the application became abandoned due to a mistake on the part of the applicant rather than the USPTO, the holding of abandonment will not be withdrawn.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute,

the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioner decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be \$1,500.00 for other than a small entity.

Petitioner may wish to consider filing an Express Abandonment in Application Nos. 10/705,678 and 10/792,671.

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703)872-9306
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Form PTO/SB/64
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